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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,907	02/09/2004	Hubertus Edward Paprotna	2004P00441US	8785
28524 7590 11/27/2007 SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN, NJ 08830			EXAMINER PATEL, VISHAL A	
			ART UNIT 3676	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/774,907  
Filing Date: February 09, 2004  
Appellant(s): PAPROTNA ET AL.

**MAILED**

**NOV 27 2007**

**GROUP 3600**

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Paprotna et. al.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/8/07 appealing from the Office action mailed 9/28/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows: Claims 1, 3-4 and 6-20 are pending in the patent application, and claims 1, 3-4 and 6-7 are rejected. Claims 2 and 5 have been canceled without prejudice, and claims 8-20 have been withdrawn. Claims 1, 3-4 and 6-7 are being appealed.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The amendment after final rejection filed on 12/5/06 has been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,524,981	Hertz, Jr.	6-1985
5,975,844	Milazar et al	11-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hertz, Jr. (US. 4,524,981).

Hertz discloses a seal having a body (body of 20), the body has a cross-section having a first side (side adjacent to 16), a second side (side adjacent to 18), a first end (end near 12) and a second end (second end near 14), the first and second side have lengths longer than lengths of the first and second ends (see figure 2-3), the first end having at least one tooth (tooth above cut 30) extending from a region on the first end proximate to an intersection between the first end and the first side and extending toward the second side (figures 2-3) and the first end having at least a second tooth (tooth below cut 30) extending from a region on the first end proximate to an intersection between the first end and the second side and extending toward the first side of the body. The at least first tooth has an angle relative to an outer surface of the first end. The at least second tooth has an angle relative to an outer surface of the first end.

2. Claims 1, 3 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Milazar et al (US. 5,975,844).

The cross-section is taken perpendicularly to the cross-section shown in figure 2. For this cross-section a body (body of 10) having a first side is 3b that extends along an annular portion in a semi-circular form and a second side is 3a that extends along an annular portion in a semi-

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circular form. The body having a first end (top surface having profile. 9a) and a second end (end having 9b). The first end having at least one tooth (one of 20) extending from a region on the first end proximate to an intersection between the first end and the first side and extending toward the second side and the first end having at least a second tooth (other of tooth 20) extending from a region on the first end proximate to an intersection between the first end and the second side and extending toward the first side of the body.

The at least one first tooth extending from the region on the first end proximate to the intersection between the first end and the first side comprises three teeth (three of 20 that are near 3a) and the at least one second tooth extending from the region on the first end proximate the intersection between the first end and the second side comprises three teeth (three of 20 that are near 3b).

Regarding claim 3: The at least one tooth is at an angle of between about 30-60 degrees relative an outer surface (surface parallel to 4) of the first end.

3. Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertz, Jr..

Hertz discloses the claimed invention except for the angle being 30-60 degrees for the teeth. Discovering an optimum range of a result effective variable involves only routine skill in the art. In re Kulling, 895 F.2d 1147, 14 USPQ 2d 1056. Without the showing of some unexpected result. Since applicant has not shown some unexpected result the inclusion of this limitation is considered to be a matter of choice in design. It would have been obvious to one having ordinary skill in the art at the time the invention was made have the angle of the teeth to be 30-60 degrees as a matter of design choice or mechanical expedience.

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Hertz discloses the claimed invention except the angle to be 45 degrees for the teeth. Discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Without the showing of some unexpected result. Since applicant has not shown some unexpected result the inclusion of this limitation is considered to be a matter of choice in design. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the angle of the teeth to be 45 degrees as a matter of design choice or mechanical expedience.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milazar.

Milazar discloses the claimed invention except the angle to be 45 degrees for the teeth. Discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Without the showing of some unexpected result. Since applicant has not shown some unexpected result the inclusion of this limitation is considered to be a matter of choice in design. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the angle of the teeth to be 45 degrees as a matter of design choice or mechanical expedience.

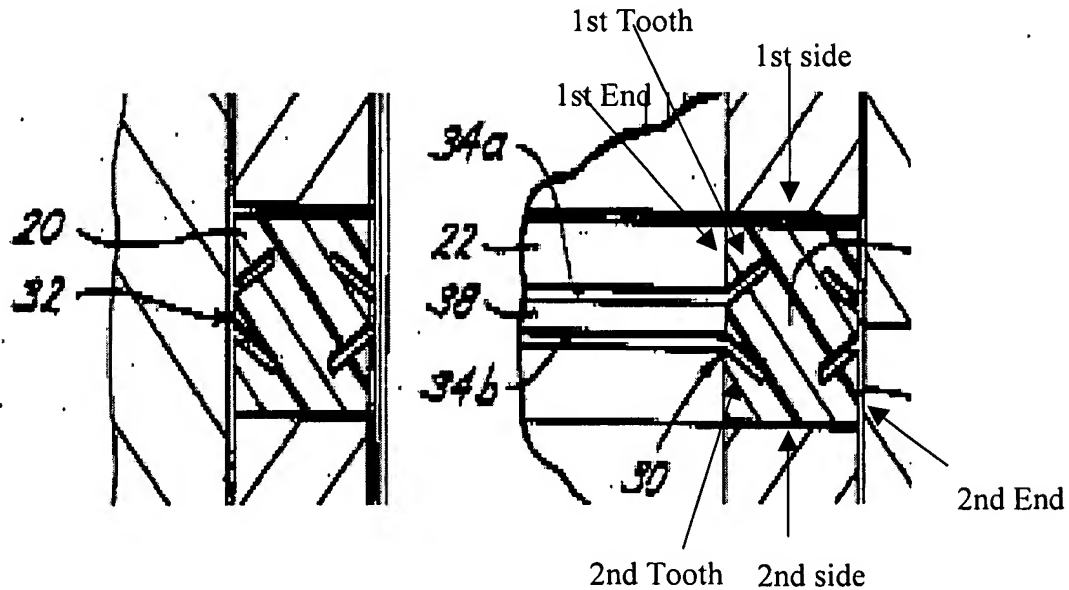
#### **(10) Response to Argument**

Appellants' arguments filed 10/8/07 have been fully considered but they are not persuasive.

**Response to arguments for claim 1 by Hertz, Jr.:** Appellants argument that Hertz does not disclose tooth extending from first and second ends but a V-cut is not persuasive because as shown in the figure below Hertz discloses a first end, a second end, a first side and a second side,

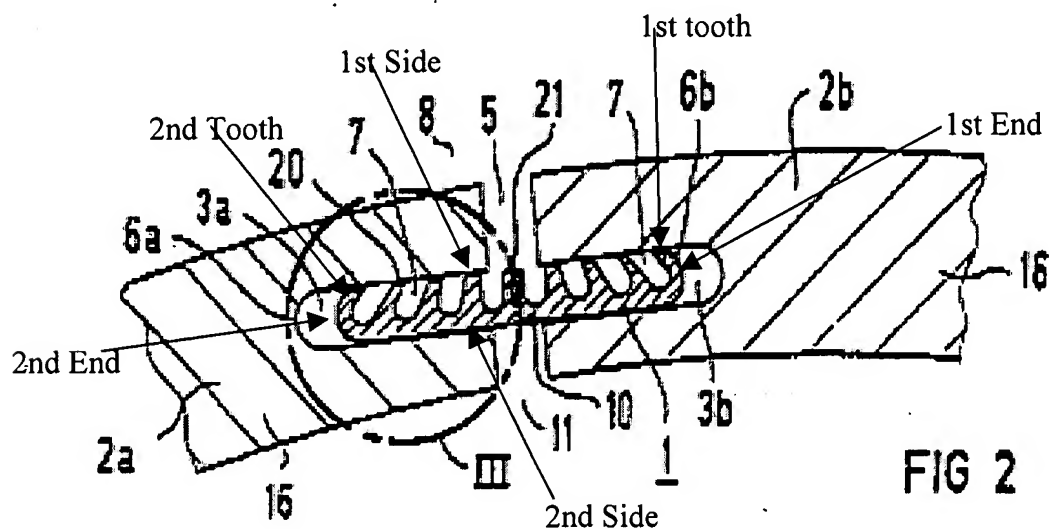
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the first end having a 1<sup>st</sup> tooth and the second end having a 2<sup>nd</sup> tooth and the teeth extend towards each other (see figure below).



**Response to arguments for claim 1, 3 and 6-7 by Milazar:** Appellants argument that Milazar fails to disclose teeth is not persuasive because in short Milazar teaches a seal element having a first side, a second side, a first end and a second, the first end having a tooth and the second end having a tooth and the teeth extend toward each other (please see figure below).

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Response to arguments for claims 3-4: Appellants arguments are not persuasive because Hertz discloses all the limitations of claim 1. Furthermore Milazar discloses all the limitations of claims 1 and 3.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

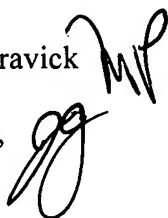
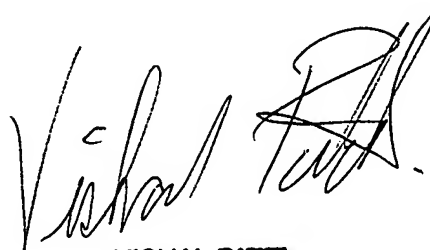
VP

Conferees:

Vishal Patel, VP

Meredith Petravick

Jennifer Gay,

Handwritten signatures of Meredith Petravick and Jennifer Gay.Handwritten signature of Vishal Patel.

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